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EXAMINER

TRAN, NGHI V

ART UNIT PAPER NUMBER

2151

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/917,070

Applicant(s)

ABDULRAHIMAN ET AL.

Examiner

Nghi V Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-96 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-96 is/are rejected.
- 7) ☒ Claim(s) 12, 19, 26, 30, 33, 39, 42, 44, 49, 51, 59, 64, 65, 68, 82, 88 and 96 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/09/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 12, 19, 26, 30, 33, 39, 42, 44, 49, 51, 59, 64, 65, 68, 82, 88, and 96 are objected to because of the following informalities:

The phrase "selected from" appears to be improper Markush language. Examiner suggests to replace "selected from" with --selected from the group consisting of--. See MPEP 2173.05(h).

Appropriate correction is required.

Claim Interpretations

2. In claims 53, 60, 61, 66, 81, and 85, the applicant wrote "... if the ..." (emphasis added). There are two possible occurrences for the "if" condition. The "if" condition is either TRUE or FALSE. For example, in claim 60, the limitation "sending a list of unacceptable remote sources and wirelessly transmitting the requested data to the portable electronic device" only occurs and has patentable weight if the condition claimed by applicant is TRUE. If the condition claimed by applicants is FALSE (or it does not occur), then any limitation associates with the "if" condition will not have any patentable weight.

The "if" limitation occurs many times in this application. For purpose of examination, the examiner only explains one specific claim interpretation as discussed above. All other "if" limitation will have the similar claim interpretations.

Claim Rejections - 35 USC § 102

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 7, 9-12, 16-18, 23, 28, 30-31, 33, 35, 36, 42, 44, 46, 51, 53-54, 58-59, 67-71, 80 are rejected under 35 U.S.C. 102(e) as being anticipated by Lincke et al., U.S. Patent Application Publication 2002/0109706 (hereinafter Lincke).

Taking claim 1 as an exemplary claim, Lincke teaches a method of transferring electronic data from a remote location to an electronic device over a bandwidth-constrained connection, the method comprising:

- selecting electronic data using an electronic device (items 101, 110, and 120 of figure 1; and paragraph 0089, page 5);
- determining whether the electronic data has a supported format (items 102 and 104 of figure 1; and paragraph 0090, page 6); and
- automatically issuing a transfer instruction for the electronic data based on acceptability criteria, the acceptability criteria comprising whether the electronic data has a supported format (items 122 and 124 of figure 1; and paragraphs 0094-0097, page 6).

With respect to claim 7, Lincke further teaches selecting electronic data comprises sending a request to view an Internet web page (paragraph 0087, page 5; and paragraph 0122, page 8).

With respect to claim 9, Lincke further teaches sending a request to view an Internet web page comprises activating a hyperlink (paragraphs 0095 and 0097, page 6; paragraph 0130, page 8; and paragraph 0382, page 81).

With respect to claim 10, Lincke further teaches selecting electronic data comprises sending a request to transfer an electronic file (items 122 and 124 of figure 1; and paragraph 0087, page 5).

With respect to claim 11, Lincke further teaches sending a request to transfer an electronic file comprises issuing a request to download the electronic file from a remote source location (figure 1).

With respect to claim 12, Lincke further teaches the electronic device is selected from a handheld computer, a pager, and a mobile phone (item 100 of figure 1; and paragraph 0087, page 5).

With respect to claim 16, Lincke further teaches the transfer instruction comprises an instruction to transfer the electronic data to the electronic device (item 206 of figure 2; and item 134 and 132 of figure 1).

With respect to claim 17, Lincke further teaches a transfer instruction comprises an instruction to transfer the electronic data over a wireless connection (figure 1 and paragraph 0087, page 5).

With respect to claim 18, Lincke further teaches transferring the selected electronic data in response to the transfer instruction (item 206 of figure 2; and paragraphs 0143-0145, page 9).

With respect to claim 23, Lincke further teaches filtering the requested information to exclude incompatible information (paragraph 0129, page 8).

With respect to claim 33, Lincke further teaches the source location is selected from the group consisting of a computer, an electronic file server, and another electronic device (item 140 of figure 1).

With respect to claim 35, Lincke teaches a method of collecting electronic data from a remote source, the method comprising:

- sending an electronic data request from an electronic device to a data transmission system, the electronic device being in wireless communication with the data transmission system (items 105, 122, 124 of figure 1);
- gathering the requested data from a remote source and storing a copy of the requested data in the data transmission system (item 180 of figure 1);
- determining within the data transmission device whether the gathered data is compatible with applications included in the electronic device (items 132 and 134 of figure 1);
- and wirelessly transmitting only compatible data to the electronic device (item 170 of figure 1).

With respect to claim 36, Lincke further teaches the data transmission system comprises a proxy server and means for wirelessly transmitting and receiving data (item 180 of figure 1).

Claims 28, 30-31, 42, 44, 46, 51, 53-54, 58-59, 67-71, 80 are also rejected for the same reason set forth in claims 1, 7, 9, 10-12, 16-18, and 23, 33, 35, and 36.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3, 13-15, 24-25, 29, 37-38, 47-48, 55-56, 72, 81-82, 86-89, and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lincke as applied to claims 1, 23, 35, 46, 53, and 67 above, and further in view of Hsing Mei, Fu Jen Catholic University, Taiwan (hereinafter Hsing).

Taking claim 2 as an exemplary claim, Lincke fails to teach sending a list of supported formats to a proxy server. However, Lincke teaches a list of supported formats (paragraph 0148, page 9). In wireless communication method, Hsing teaches sending a list of supported formats to a proxy server (item 1 of figure 2, page 5 of 14; and Example section, page 8 of 14). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lincke in view of Hsing by sending a list of supported formats to a proxy server. The motivation for doing so would

have been obvious because a list allows the proxy server to respond the client with the right data format.

With respect to claim 3, claim 3 is also rejected for the same reasons set forth in claim 2 and Lincke further teaches selecting the electronic data (paragraphs 0148-0152, pages 9-10; and item 100 of figure 1).

Claims 13-15, 24-25, 29, 37-38, 47-48, 55-56, 72, 81-82, 86-89, and 93 are also rejected for the same reasons set forth in claims 2 and 3.

7. Claims 4-6, 19, 26-27, 39-41, 49-50, 61-65, 73-75, 83-84, and 90-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lincke and Hsing as applied to claims 1-2, 23-24, 35, 37, 46, 67, 72, 81, 86, and 89 further in view of RealPlayer 8 Plus User Manual, RealSystem, Inc. (hereinafter RealPlayer).

With respect to claim 4, both Lincke and Hsing fail to teach automatically updating the list of supported formats. On the other hand, Chris teaches automatically updating the list of supported formats to reflect the changes in applications included in the electronic device (page 10 of 11). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify both Lincke and Hsing in view of RealPlayer by automatically updating the list. The motivation for doing so would have been obvious because it ensures that clients can play or view other file types as soon as they are introduced.

Claims 5-6, 19, 26-27, 39-41, 49-50, 61-65, 73-75, 83-84, 90-92 are also rejected for the same reasons set forth in claim 4.

8. Claims 8, 32, 43, 57, 78-79, 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lincke as applied to claims 1,7, 23, 35, 53, 67, 86 and 93 above, and further in view of Rich Hall, Pocket PC Magazine (hereinafter Rich).

With respect to claim 8, Lincke fails to teach entering an Internet web page address in an Internet web browser. However, Lincke teaches sending a request to view an Internet web page. In wireless communication method, Rich teaches sending a request to view an Internet web page comprises entering an Internet web page address in an Internet web browser (page 2 of 3 and "Address" section of screenshot 2). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lincke in view of Rich by entering an Internet web page address in an Internet web browser. The motivation for doing so would have been obvious because it increases the client's flexibility that allows clients to browse any websites.

Claims 32, 43, 57, 78-79, and 94 are also rejected for the same reason set forth in claim 8.

9. Claims 20-22, 34, 45, 52, 60, 66, and 76-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lincke as applied to claims 1, 23, 35, 46, 53, 61, and 67 above, and further in view of Chris De Herrera, CEWindows.NET (hereinafter Chris).

Taking claim 20 as an exemplary claim, Lincke fails to teach sending a list of unacceptable source locations to a proxy server. In wireless communication, Chris teaches sending a list of unacceptable source locations to a proxy server (page 1 of 10). It would have been obvious to one having ordinary skill in the art at the time of the

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invention was made to modify Lincke in view of Chris by sending a list of unacceptable source locations to a proxy server. The motivation for doing so would have been obvious because it allows to create custom channels or filter unwanted source location.

With respect to claim 21, Lincke further teaches the acceptability criteria further comprises whether the electronic data has an acceptable source location (item 104 of figure 1).

With respect to claim 22, claim 22 is rejected for the same reason set forth in claim 20. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lincke in view of Chris by teaching the electronic data has a supported format and an unacceptable source location and the transfer instruction comprises an instruction not to send the electronic data to the electronic device. The motivation for doing so would have been obvious because proxy server does not have to send instruction to electronic device that reduces the bandwidth and high latency communications.

Claims 34, 45, 52, 60, and 76-77 are also rejected for the same reason set forth in claims 20-22 above.

10. Claims 66, 85 and 95-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lincke, Hsing, and RealPlayer as applied to claims 1, 23, 35, 46, 53, 61, 67, 81, and 86 above, and further in view of Chris De Herrera, CEWindows.NET (hereinafter Chris).

With respect to claim 66, Lincke, Hsing, and RealPlayer fail to teach a list of unacceptable remote location. On the other hand, Chris teaches generating a list of

unacceptable remote locations and wirelessly transmitting the electronic information to the electronic device only if the web page does not originate from an unacceptable remote location (page 1 of 10). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Lincke, Hsing, and RealPlayer in view of Chris by transmitting a list of unacceptable remote location to the electronic device. The motivation for doing so would have been obvious because proxy server does not have to send instruction to electronic device that reduces the bandwidth and high latency communications.

Claims 85 and 95-96 are also rejected for the same reason set forth in claims 66, 81, and 86 above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. "Information Communication Processor," by Yoshida Shinichi, Japan Publication, 11-313172.
- b. "WAP Gateways and Servers," by Jeff Michalski,
http://www.techonline.com/community/ed_resource/feature_article/5580?print
- c. "WAP Deployment Fact Sheet," by WAP Forum,
http://www.wapforum.org/new/WAP_Deployment_Fact_Sheet_022000.doc
- d. "Microsoft and Industry Partners Announce Next-Generation Windows-Powered Handheld PCs," by Microsoft,
<http://www.microsoft.com/presspass/press/2000/Sept00/HPCPR.asp>


- e. "It's What's Under the Hood that Counts!" by Chris De Herrera,
http://www.pocketpcmag.com/_archives/Jul00/underhood.asp
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N.T.

Nghi V Tran
Examiner
Art Unit 2151


ZARNI MAUNG
PRIMARY EXAMINER